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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/543,015	05/09/2006	Mark Patrick	03164.0186USWO	4051
23552 7590 08/13/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903				
EXAMINER				
DARNER, CHRISTOPHER J				
ART UNIT		PAPER NUMBER		
3633				
MAIL DATE		DELIVERY MODE		
08/13/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/543,015

Applicant(s)

PATRICK ET AL.

Examiner

CHRISTOPHER J. DARNER

Art Unit

3633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-3, 6, and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903).**

With respect to claim 1, Stemler teaches a strengthening component in the form of an inverted channel member secured to the base component (16), with the channel member (14) including two opposed side walls (20) formed from web components and a top formed from a chord component (18), at column 4, lines 53-54. Stemler does not teach the web and top chord components being manufactured as separate components and thereafter assembled together to form the channel member. However, "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-

process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

Stemler does not teach a base component that includes a central pan and lap joints on each side of the pan to enable adjacent main decking panels to be positioned side by side in overlapping relationship. Hertweck teaches a base component that includes a central pan (11) and lap joints (13) on each side of the pan to enable adjacent main decking panels to be positioned side by side in overlapping relationship in Figure 1. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler by including a base component that includes a central pan and lap joints on each side of the pan to enable adjacent main decking panels to be positioned side by side in overlapping relationship as taught by Hertweck in order to provide a support foundation for main deck panel.

With respect to claim 2, Stemler does not teach the main decking panel wherein the central pan includes at least one longitudinal stiffener. Hertweck teaches the main decking panel wherein the central pan includes at least one longitudinal stiffener at column 4, lines 23-27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler by including the main decking panel wherein the central pan includes at least one longitudinal stiffener as taught by Hertweck in order to provide stiffness and strength to the central pan.

With respect to claim 3, Stemler does not teach secured locations between the longitudinal stiffener or stiffeners and the lap joints. Hertweck teaches secured locations between the longitudinal stiffener or stiffeners and the lap joints at column 4,

lines 29-33. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler by including the main decking panel wherein the web components are secured to the base component at locations between the longitudinal stiffener or stiffeners and the lap joints as taught by Herweck in order to increase the rigidity of the main decking panel.

With respect to claim 6, Stemler teaches the main decking panel wherein the strengthening component (22) is secured to the base component (16) at a plurality of discrete connection locations along the length of the channel member in Figure 1. It is understood that each strengthening component is secured to the base component at a discrete location as illustrated in Figure 1.

With respect to claim 10, Stemler in view of Hertweck does not teach the main decking panel wherein the web components and the top chord components are assembled together by securing the components together at a plurality of discrete connection locations along the lengths of the components. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the web components and the top chord components are assembled together by securing the components together at a plurality of discrete connection locations along the lengths of the components in order to provide attachment points between the web and chord at various areas.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) as applied to claim 1 above, and further in view of Holmgren (U.S. Patent # 3,583,123.

Stemler in view of Hertweck does not teach the main decking panel wherein the lap joints are formed so that a successive decking panel can be positioned in sided by side overlapping relationship with another decking panel by pressing the lap joint of the successive decking panel downwardly over the lap joint of the other decking panel. Holmgren teaches the main decking panel wherein the lap joints are formed so that a successive decking panel can be positioned in sided by side overlapping relationship with another decking panel by pressing the lap joint (32) of the successive decking panel downwardly over the lap joint (40) of the other decking panel at column 3, lines 2-6. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the lap joints are formed so that a successive decking panel can be positioned in sided by side overlapping relationship with another decking panel by pressing the lap joint of the successive decking panel downwardly over the lap joint of the other decking panel as taught by Holmgren in order to facilitate the connection of consecutive decking panels.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) and further in view of Stohs (U.S. Patent # 4,726,159).

With respect to claim 7, Stemler in view of Hertweck does not teach the main decking panel wherein the strengthening component is secured to the base component at the plurality of discrete connection locations by deformed sections of the components at the locations that interlock the components together. Stohs teaches the main decking panel wherein the strengthening component is secured to the base component at the plurality of discrete connection locations (52, 48) by deformed sections of the components at the locations that interlock the components together at column 6, lines 50-54 and lines 59-62. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the strengthening component is secured to the base component at the plurality of discrete connection locations by deformed sections of the components at the locations that interlock the components together as taught by Stohs in order to provide increased stability and structural strength for the decking panel.

With respect to claim 8, Stemler in view of Hertweck in view of Stohs teaches the claimed invention except for button shaped deformed section. It would have been obvious to one having ordinary skill in the art at the time the invention as made to shape the deformed section as a button, a change in the shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to claim 9, Stemler in view of Hertweck does not teach the main decking panel wherein the deformed sections are formed by holding the components together and pressing the deformed sections, such as buttons, from one side of the components. Stohs teaches the main decking panel wherein the deformed sections are formed by holding the components together (compression) and pressing the deformed sections, such as buttons, from one side of the components at column 7, lines 4-8. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the deformed sections are formed by holding the components together and pressing the deformed sections, such as buttons, from one side of the components as taught by Stohs in order to provide a snap-like engagement to the connection.

5. Claims 11-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) and further in view of Ryan (U.S. Patent # 4,453,349).

With respect to claim 11, Stemler in view of Hertweck does not teach the main decking panel wherein the web components and the top chord components are assembled together at the plurality of discrete connection locations by deformed sections of the components at the locations that interlock the components together. Ryan teaches the main decking panel wherein the strengthening component is secured to the base component at the plurality of discrete connection locations (1b) by deformed sections of the components at the locations that interlock the components together in

Figure 9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the strengthening component is secured to the base component at the plurality of discrete connection locations by deformed sections of the components at the locations that interlock the components together as taught by Ryan in order to provide increased stability and structural strength for the decking panel.

With respect to claim 12, Stemler in view of Hertweck teaches the claimed invention except for button shaped deformed section. It would have been obvious to one having ordinary skill in the art at the time the invention was made to shape the deformed section as a button, a change in the shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). Note that those of ordinary skill in the art would appreciate that a modification such as a mere change in shape of a prior art device is a design consideration within the skill of the art. *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

With respect to claim 13, Stemler in view of Hertweck does not teach the main decking panel wherein the deformed sections are formed by holding the components together and pressing the deformed sections, such as buttons, from one side of the components. Ryan teaches the main decking panel wherein the deformed sections are formed by holding the components together (compression) and pressing the deformed sections, such as buttons, from one side of the components at column 2, lines 28-31. It would have been obvious to one having ordinary skill in the art at the time the invention

was made to modify Stemler in view of Hertweck by including the main decking panel wherein the deformed sections are formed by holding the components together and pressing the deformed sections, such as buttons, form one side of the components as taught by Ryan in order to provide a snap-like engagement to the connection. "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process."

With respect to claim 14, Stemler in view of Herweck does not teach the main decking panel wherein the web components include flanges and the web and top chord components are secured together at the flanges. Ryan teaches the main decking panel wherein the web components include flanges and the web and top chord components are secured together at the flanges (1b) at column 2, lines 23-27. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the web components include flanges and the web and top chord components are secured together at the flanges as taught by Ryan in order to provide a balanced main deck panel that has the substantially the same resistance to both compression and tension loading forces.

6. Claims 15-17, and 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) as applied to claim 1 above, and further in view of Gray (U.S. Patent # 4,594,826).

With respect to claim 15, Stemler in view of Hertweck does not teach the main decking panel wherein the top chord component includes one or more than one longitudinal stiffener. Gray teaches the main decking panel wherein the top chord component includes one or more than one longitudinal stiffener (102) at column 4, lines 45-48. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the top chord component includes one or more than one longitudinal stiffener as taught by Gray in order to provide stiffness and strength to the top chord component.

With respect to claim 16, Stemler in view of Hertweck does not teach the main decking panel wherein the stiffener or stiffeners extend along the length of the top chord component. Gray teaches the main decking panel wherein the stiffener or stiffeners (102) extend along the length of the top chord component in Figure 4. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the stiffener or stiffeners extend along the length of the top chord component as taught by Gray in order to provide stiffness and strength to the top chord component.

With respect to claim 17, Stemler in view of Hertweck does not teach the main decking panel wherein the top chord component includes down-turned sides. Gray teaches the main decking panel wherein the top chord component includes down-turned sides (58) in Figure 2. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the top chord component includes down-turned sides as taught by Gray in order to provide a potential attachment location.

With respect to claim 20, Stemler in view of Hertweck does not teach the main decking panel wherein web components include openings to allow concrete to flow into the channel member. Gray teaches the main decking panel wherein web components include openings (70, 72) to allow concrete to flow into the channel member at column 4, lines 12-17. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein web components include openings to allow concrete to flow into the channel member as taught by Butler in order to anchor the channel member of the main decking panel.

7. Claims 4, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) as applied to claim 1 above, and further in view of Albrecht (U.S. Patent # 4,962,622).

With respect to claim 4, Stemler in view of Hertweck does not teach the main decking panel wherein the web components butt against the longitudinal stiffener or stiffeners and/or lap joints. Albrecht teaches the main decking panel wherein the web components butt against the longitudinal stiffener or stiffeners and/or lap joints at column 5, lines 25-30 and Figure 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the web components butt against the longitudinal stiffener or stiffeners and/or lap joints as taught by Albrecht in order to increase the structural integrity of the main decking panel.

With respect to claim 18, Stemler in view of Hertweck does not teach the main decking panel wherein the web components include corrugations. Albrecht teaches the main decking panel wherein the web components include corrugations (98) at column 5, lines 5-9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel wherein the web components include corrugations as taught by Albrecht in order to enhance the composite co-action between the main decking panels and the overlying concrete layer.

With respect to claim 19, Stemler in view of Hertweck does not teach the main decking panel wherein the corrugations (98) are vertical corrugations. Albrecht teaches the main decking panel wherein the corrugations are vertical corrugations in Figure 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the main decking panel

wherein the web components include corrugations as taught by Albrecht in order to enhance the composite co-action between the main decking panels and the overlying concrete layer.

8. Claims 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stemler (U.S. Patent # 4,709,435) in view of Hertweck (U.S. Patent # 6,434,903) as applied to claim 1 above, and further in view of Albrecht (U.S. Patent # 4,085,558).

With respect to claim 21, Stemler in view of Hertweck does not teach the structural decking system formed from a plurality of the main decking panel positioned side by side with the lap joint in overlapping relationship. Albrecht teaches the structural decking system formed from a plurality of the main decking panel (28) positioned side by side with the lap joint (36) in overlapping relationship at column 4, lines 20-23. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the structural decking system formed from a plurality of the main decking panel positioned side by side with the lap joint in overlapping relationship as taught by Albrecht in order to provide anchor sites for additional devices.

With respect to claim 22, Stemler in view of Hertweck does not teach the structural decking system includes one or more than one infill decking panel that is positioned between two main decking panels, with the infill decking panel including lap joints one each side of the pan that are in overlapping relationship with the lap joints of

adjacent main decking panels. Albrecht teaches the structural decking system includes one or more than one infill decking panel (32) that is positioned between two main decking panels, with the infill decking panel including lap joints (52, 54) one each side of the pan that are in overlapping relationship with the lap joints (36) of adjacent main decking panels at column 4, lines 13-16, Figure 1 and Figure 3. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including the structural decking system includes one or more than one infill decking panel that is positioned between two main decking panels, with the infill decking panel including lap joints one each side of the pan that are in overlapping relationship with the lap joints of adjacent main decking panels as taught by Albrecht in order to allow for present and future distribution of electrical services throughout the floor structure.

With respect to claim 23, Stemler in view of Hertweck does not teach a composite slab that includes the structural decking system and a layer of hardened concrete on the structural decking system. Albrecht teaches a composite slab that includes the structural decking system and a layer of hardened concrete (24) on the structural decking system at column 4, lines 7-9. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Stemler in view of Hertweck by including a composite slab that includes the structural decking system and a layer of hardened concrete on the structural decking system as taught by Albrecht in order to provide a stable strong floor fill.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Maurer (U.S. Patent # 3,667,185) teaches panel and lap joint made therefrom, Haszler et al. (U.S. Patent # 6,848,233) teaches composite aluminium panel, Kenaga (U.S. Patent # 3,740,916) teaches panel construction, Nurley et al. (U.S. Patent # 6,250,036 B1) teaches sound control system for steel roof decks, Meredith (U.S. Patent # 6,568,144 B2) teaches metal construction panel, Bailey (U.S. Patent # 2,682,939) teaches building structure, Gray (U.S. Patent # 4,594,826) teaches field – assembled raceway forming member, and Albrecht et al. (U.S. Patent # 3,812,636) teaches sheet metal decking unit and composite floor construction utilizing the same.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER J. DARNER whose telephone number is (571)270-3658. The examiner can normally be reached on Monday thru Friday 7:30AM to 4:00PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian V. Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3633

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Darnier/
Examiner, Art Unit 3633

/Brian E. Glessner/
Supervisory Patent Examiner, Art Unit 3633